

I. REAL PARTY IN INTEREST (37 C.F.R. § 41.37(c)(1)(i))

The real party in interest in this appeal is Nokia Corporation, a corporation organized under the laws of Finland.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 41.37(c)(1)(ii))

There are no related appeals or interferences.

III. STATUS OF CLAIMS (37 C.F.R. § 41.37(c)(1)(iii))

Claims 1-6 and 10-14 are pending in this application. Claim 1-6 and 10-14 are rejected, and the rejection of claims 1-6 and 10-14 is being appealed.

IV. STATUS OF AMENDMENTS (37 C.F.R. § 41.37(c)(1)(iv))

No amendment was filed after the final rejection, and therefore all amendments have been entered.

V. SUMMARY OF CLAIMED SUBJECT MATTER (37 C.F.R. § 41.37(c)(1)(v))

Independent claim 1 is directed to an apparatus that includes an already existing electronic communication or player device (1) having a screen display. See Figures 1 & 3; page 2, lines 1-3 & 29-31. The apparatus also includes one or more pointing device components (2, 3, 4, 5) integrated into the already existing electronic communication or player device (1). See Figures 1-3; page 3, lines 21-26. In claim 1, the one or more pointing device components (2, 3, 4, 5) are configured to give the already existing electronic communication or player device (1), in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device. See page 2, lines 1-3; page 3, lines 27-29. In claim 1, the auxiliary function enables the already existing electronic communication or player device (1) to act together with the external electronic screen display device, where the pointing device being operates independently of a functionality of the existing electronic communication or player device (1). See specification page 1, lines 16-22. The external electronic screen display device is other than the screen display of the already existing electronic communication or player device (1). See specification page 2, lines 22-23.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. §

41.37(c)(1)(vi))

Claims 1-6 and 10-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Miyashita* (U.S. Patent No. 6,909,906) in view of *Steele* (U.S. Patent No. 6,201,534), and in further view of *Lee* (U.S. Appl. Publ. No. 2003/0016417).

VII. ARGUMENT (37 C.F.R. § 41.37(c)(1)(vii))

Rejection under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,909,906 in view of U.S. Patent No. 6,201,534, and further view of U.S. Appl. Publ. No. 2003/0016417

Claim 1

Appellant respectfully submits that claim 1 is not disclosed or suggested by the cited references, alone or in combination, because the cited references fail to disclose or suggest all of the limitations recited in claim 1. Appellant respectfully submits that the cited references, alone or in combination, at least fail to disclose or suggest that the one or more pointing device components are configured to give the already existing electronic communication or player device, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device, thus enabling the already existing electronic communication or player device to act together with the external electronic screen display device, and the external electronic screen display device is other than the screen display of the already existing electronic communication or player device, as recited in claim 1.

The Office acknowledges on page 3 of the Office Action, that *Miyashita* does not disclose that the already existing electronic communication device or player device acts together with the external electronic screen display device, and relies upon *Steele* for this teaching. However, applicant respectfully submits that *Steele* also fails to disclose or suggest that an already existing electronic communication or player device acts together with an external electronic screen display device, where the external electronic screen display device is other than the screen display of the already existing electronic communication or player device, as recited in claim 1. The Office asserts that video monitor (416a) of Figure 6A of *Steele* corresponds to the external electronic screen display device, as recited in claim 1. However, the video monitor (416a) is part of the remote control system (400a) that includes the electronic controller (414a) and the video monitor (416a). *See Steele* column 6, lines 41-44. Therefore, the video monitor (416a) of *Steele* cannot be the external electronic screen display device of claim 1, because it is at most the screen display of the already existing electronic communication or player device, since the remote controller (414a) does not include a display screen of its own. Claim 1 specifically states that the external electronic screen display device is other than the screen

display of the already existing electronic communication or player device. In contrast to claim 1, in *Steele*, the display screen for the remote controller (414a) is that of the video monitor (416a).

Therefore, *Steele* would provide no motivation to provide an already existing electronic communication or player device to act together with an external electronic screen display device that is not a display screen of the already existing electronic communication or player device, since *Steele* only discloses one screen display. The teachings of *Steele* suffer from the same deficiencies, as recognized by the Office, as *Miyashita* with respect to the already existing electronic communication or player device acting together with an external electronic screen display device. The Office asserts on pages 7-8 of the Office Action that since *Steele* teaches that a pointing device uses an external display screen, the combination of *Steele* and *Miyashita* would arrive at the claimed limitations. However, as discussed above, claim 1 requires an already existing electronic communication device or player device with a screen display, and that the external electronic screen display is other than the screen display of the already existing electronic communication or player device. Therefore, simply because the video monitor (416a) is not physically attached to the remote controller (414a) in *Steele* does not mean that the video monitor (416a) corresponds to the external electronic screen display device of claim 1. The Office acknowledges on page 8 of the Office Action that the remote controller (414a) does not have its own display, and merely states that because video monitor (416a) is located outside of the remote controller (414a) it corresponds to the external display screen of claim 1. However, this interpretation completely ignores the limitations of claim 1 identified above, which require a screen display and an external screen display device.

The Office appears to assert on page 9 of the Office Action that device (400a) of *Steele* can replace element (105) of *Miyashita*, or simply be added to device (102). The motivation for this modification provided by the Office appears to be that by combining the devices of *Miyashita* and *Steele* the user can use the phone and at the same time use the remote control system of *Steele*. See page 9 of Office Action. However, this motivation is based solely on impermissible hindsight reasoning, since the applicant specifically states on page 1, lines 28-30 of the specification that an object of the invention is to provide an electronic aid or communication device, which can act according to its original intention, but which also has a secondary function as a pointing device. There is no motivation to combine the cited references, because the combination is based on impermissible hindsight reasoning taken directly from the

specification of the present application. Accordingly, for at least these reasons, claim 1 is not disclosed or suggested by the cited references.

Furthermore, the Office acknowledges on page 4 of the Office Action that *Miyashita* and *Steele* do not mention that the pointing device is configured to operate independently of a functionality of the existing electronic communication or player device, and relies upon *Lee* for this teaching. The Office asserts that the functionality of the laser guiding device is separate from the functionality of the mouse. However, claim 1 requires that the already existing electronic communication or player device has, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device, thus enabling the already existing electronic communication or player device to act together with the external electronic screen display device. Merely because the laser guiding device of *Lee* may be separate from the functionality of the mouse in *Lee* does not provide one of skill in the art to modify the cited references to arrive at the limitations recited in claim 1. In particular, the projected laser beam does not enable the wireless transmission unit of *Lee* to act together with the computer (3) or projector (5). Instead, the laser pointing device merely acts as a pointer with respect to items on the screen (6). *Lee* only provides the pointer (61) that acts together with the projection screen (6) of the projector (5) in connection with the computer (3). See *Lee* paragraph [0028]. For at least the reasons discussed above, claim 1 is not disclosed or suggested by the cited references.

Claims 2-6 and 10-14

Claims 2-6 and 10-14 ultimately depend from independent claim 1, and therefore are not disclosed or suggested by the cited references at least in view of their dependencies.

Conclusion

For the reasons discussed above, applicant respectfully submits that the rejections of the final Office Action have been shown to be inapplicable, and respectfully requests that the Board reverse the rejections of pending claims 1-6 and 10-14. If any additional fee is required for submission of this Appeal Brief, the Commissioner is hereby authorized to charge Deposit Account No. 23-0442.

Respectfully submitted,

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CLAIMS APPENDIX

1. An apparatus, comprising:

an already existing electronic communication or player device having a screen display,
and

one or more pointing device components integrated into the already existing electronic communication or player device,

wherein said one or more pointing device components are configured to give the already existing electronic communication or player device, in addition to its main functions, an auxiliary function as a pointing device with respect to an external electronic screen display device, thus enabling the already existing electronic communication or player device to act together with the external electronic screen display device, and said pointing device being configured to operate independent of a functionality of the existing electronic communication or player device, and

wherein the external electronic screen display device is other than the screen display of the already existing electronic communication or player device.

2. The apparatus according to claim 1, wherein the already existing electronic communication or player device comprises optical or radio transmission means configured to establish a wireless connection with the external electronic screen display device.

3. The apparatus according to claim 1, wherein the one or more pointing device components comprise at least one of the following components: a mechanical or optical reader, a button element and a scroll wheel.

4. The apparatus according to claim 1, wherein the one or more pointing device components are integrated in an auxiliary unit, said auxiliary unit is releasably mounted to the already existing electronic communication or player device in such a manner that the auxiliary unit can be released and act as the pointing device separately from the already existing electronic communication or player device.

5. The apparatus according to claim 4, wherein the auxiliary unit further comprises optical or radio transmission means, said optical or radio transmission means is configured to establish a wireless connection with the external electronic screen display device.

6. The device according to claim 4, wherein the auxiliary unit is a battery pack of the already existing electronic communication or player device.

7-9. (Canceled)

10. The apparatus according to claim 1, wherein the already existing electronic communication or player device is one of the following devices: a mobile telephone, a personal data assistant, a digital audio player and a minidisk player.

11. The apparatus according to claim 4, wherein the one or more pointing device components comprise at least one of the following components: a mechanical or optical reader, a button element and a scroll wheel.

12. The apparatus according to claim 1, wherein the one or more pointing device components are configured in a body of the already existing electronic communication or player device in such a manner that the body is suitable for contact with a user's palm.

13. The apparatus according to claim 1, wherein the one or more pointing device components are configured to perform functionality of a mouse unit.

14. The apparatus according to claim 1, wherein the one or more pointing device components are configured in a body of the already existing electronic communication or player device in such a manner that the body appears to a user like a body of a mouse unit.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.